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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional): 004770.00032	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____		Application Number 10/066,631	Filed Feb. 4, 2002
		First Named Inventor Akseli Anttila	
		Art Unit 2611	Examiner Kieu Oanh T. Bui
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/98) <input checked="" type="checkbox"/> attorney or agent of record. Registration number 56,197 <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____			
		Signature Shawn P. Gorman Typed or printed name (312) 463-5000 Telephone number February 7, 2006 Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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First, the Office Action dated November 28, 2005 alleges the limitations “the first wireless mobile device comprising a first media player”, “the second media player comprising a second media player”, and/or “the mobile wireless device comprising a media player” are in the preamble of claims 1, 8, 16, 20 – 22 and 31.¹ (Final Office Action dated November 28, 2005; page 9). This statement, together with the remaining responses to the Applicants’ arguments, demonstrate the limitations are not being properly considered within the scope of the claims. For example, the Examiner continues to state:

In fact, claims 1 – 32 would have been rejected under 35 U.S.C., second paragraph, as failing to set forth the subject matter which the applicant(s) regard as their invention. The simple reason is because Figs. 1 and 4 – 6 of the present application straightly presenting [*sic*] a media player or a mobile device as one entity, not as separate devices. So the claimed languages [*sic*] as stated [*sic*] simply misleading and incorrect claiming for the present application.

(*Id.*) As explained below, the Applicants submit the limitations are within the scope of the claims and there is no valid rejection under 35 U.S.C. §112, 2nd paragraph.

The Applicants respectfully disagree with any assertion that the claim language is in the preamble, are therefore presumably not considered a limitation because 1) the Examiner has already acknowledged the language is a limitation that was considered when determining the scope of the claims; and 2) precedent from the Federal Circuit clearly indicates the cited text is a limitation within the scope of the claim.

First, in the Advisory Action dated August 27, 2004, the Examiner expressly admits the language is considered a limitation of the claim. In denying the Applicant’s request to enter the language as it is now presented in an After-Final Amendment, the Examiner stated:

The amendment to the claims changes the scope of the claim and introduces limitations that have not previously consider [*sic*]. For example,...“an alert message from a first mobile wireless device to a second mobile wireless device, the first mobile wireless device comprising a first media player and the second mobile wireless device comprising a second media player” as defined in claim 1 have [*sic*] not been previously consider [*sic*].

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(Advisory Action dated August 27, 2004; Page 2; emphasis added). It is unclear how the same language can be said to change the scope of the claim and introduce limitations into the claim can now not be considered a limitation.

Secondly, the Federal Circuit has ruled that "[i]f the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999); *Kropa v. Robie*, 187 F.2d 150, 152 (CCPA 1951) (A preamble reciting "An abrasive article" was deemed essential to point out the invention defined by claims to an article comprising abrasive grains and a hardened binder and the process of making it. The court stated "it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable *inter alia* of use as abrasive grains and a binder is not an 'abrasive article.'" Therefore, the preamble served to further define the structure of the article produced.).

In this case, element (a) of exemplary claim 1 recites "presenting broadcast content to a first user of the first media player;" (emphasis added). The first media player was preceded by **D. EXAMINER'S COMMENT re POSSIBLE 35 U.S.C. 112, second paragraph REJECTION**

The Office Action also asserts that treating the above language as a limitation would create a 35 U.S.C. 112, second paragraph rejection as the claim language is allegedly "simply misleading and incorrect claiming for the present application" because "Figs. 1 and 4 – 6 of the present application straightly presenting [*sic*] a media player or a mobile device as one entity, not as separate devices." As recited in exemplary claim 1, "the first mobile wireless device compris[es] a first media player and the second mobile wireless device compris[es] a second media player". The Applicants interpret this as a first mobile wireless device having a first media player and a second mobile wireless device having a second media player. Therefore, it is not entirely true that the rejected claims present "a media player or a mobile device as one

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entity, not as separate devices." In fact, each of the mobile devices have a distinct and separate media player. The Applicants point this out because the only mobile wireless device disclosed in *Laitinen* is the user terminal 510 or its equivalent (i.e., 100). Nonetheless, the Applicants submit the claims particularly point out and distinctly claim the subject matter which the Applicant regard as their invention.

C. The Merits of the Rejection

The Office Actions dated November 28, 2005 and June 29, 2005 allege *Laitinen* discloses a method of transmitting an alert message from a first mobile wireless device to a second mobile wireless device. The Actions further allege Figure 5 and the corresponding disclosure set forth in Col. 5, lines 57-65 teach transmitting an alert message from a first mobile wireless device comprising a first media player to a second mobile wireless device comprising a second media player. First, the Office Action alleges element 512 shows mobile devices. The Applicants note that element 512 refers to a dedicated button. The Applicants assume the Examiner is referring to the DVB receivers represented by element 510 and request clarification if this is erroneous. Figure 5 and the corresponding written description, however, show a content updating server 502 updating a DVB gateway 504 with content which forwards the content to a DVB base station 506. The only mobile wireless devices disclosed in the cited text is the user terminals 510.

Indeed, neither the content updating server, DVB gateway, or base station appear to provide a mobile device, nor do they have a comprise a first media player, nevermind the functionality to generate at the first media player the alert message formatted to reconfigure the second media player to provide the broadcast content to a second user of the second media player. Rather, the disclosed system is only capable of transmitting content to one or more user terminals. If the Office Action is alleging that the multiple user terminals 510 may serve as the first and second mobile wireless devices, the Applicants request clarification where *Laitinen* teaches generating at the first media player the alert message formatted to reconfigure the second media player to provide the broadcast content to a second user of the second media player.

While the specification does mention the possibility of a plurality of mobile devices 510, to receive the transmissions from the DVB station, there is no disclosure, teaching, or suggestion of transmitting an alert message between the mobile devices as claimed by the rejected claims. As readily seen, *Laitinen* does not disclose or suggest a method or a system capable of

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transmitting a tune alert message (whether digital or analog) from a first media player to a mobile device comprising a second media player. The Applicants therefore respectfully request reversal of the rejection in regards to claims 1, 32, and those directly or indirectly depending from them. Moreover, for at least the above reasons, claims 16 and 20, and 32 (and their dependent claims) are distinguishable over the cited art as *Laitinen* does not show each and every claimed element of the recited claims. Specifically, the Office Action states claims 20, 29, and 32 "are rejected for the reason given in the scope of claims 1, 8 and 16." (O.A. dated June 29, 2005, page 7). Claims 1 and 16 have been discussed above, and the rejections addressing claim 8 are adequately discussed in the Response dated September 27, 2005.

While Applicants believe the above points represent the clearest errors made by the Office, Applicants reserve the right to appeal on other bases and errors. In addition, Applicants believe the rejections of other claims not identified above are also based on one or more Office errors. Applicants will address such issues on appeal should the appeal of this case proceed after the Office's consideration of this paper.

CONCLUSION


All issues having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. However, if for any reason the review panel believes the application is not in condition for allowance or there are any questions, the review panel is invited to contact the undersigned at (312) 463-5434.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated this 7th day of February, 2006

By:


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